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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,901	05/15/2002	Wolfgang Schweiker	SI01-014	8238

7590  
Walter M Douglas  
Corning Incorporated  
SP-TI-03  
Corning, NY 14831

02/25/2004

EXAMINER

KRISHNAN, SUMATI

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/031,901	<b>Applicant(s)</b> SCHWEIKER ET AL.	
	<b>Examiner</b> Sumati Krishnan	<b>Art Unit</b> 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0402</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities:

Line 10 contains the characters “characterized by]” which are out of place.

Line 10 also contains the word “wherein a second holding block.” The word “wherein” should be deleted.

Line 13 starts “by a spring element” the “by” should be deleted.

Appropriate correction is required.

2. Claim 11 is objected to because of the following informalities:

Line 1 contains the phrase “wherein is formed by...” which should read “wherein the spring element is formed by...” Appropriate correction is required.

3. Claim 16 is objected to because of the following informalities: the words in the claim are jumbled and out of order. Appropriate correction is required.

### ***Double Patenting***

Claims 1-18 of this application conflict with claims 1-16 of Application No. 10/031916. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one

application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Harman (US 5727099).

Regarding claim 1, Harman discloses an optical coupling device for injecting light between end faces of two optical waveguides, said device comprising a holding element 26 for holding a first optical waveguide 28, a first holding block 34 which is fitted to the second optical waveguide 32, an elongate variable length element (see figure 2, where the variable length element would be a first half of element 36, the half located closer to element 34) which is supported on the first holding block 34, and extends in its longitudinal direction, starting from the first holding block parallel to the end face of the second optical waveguide and on which the holding element 26 is provided so that the geometrical position of the end face of the first optical waveguide 28 can be varied with respect to the end face of the second optical waveguide, a second holding block 40 which with respect to the longitudinal direction of the variable length element is arranged on the side of the latter facing away from the first holding block, and a spring element, (a second half of element 36 – the half located closer to element 40 in figure 2)

which is arranged between the variable length element (first half of element 36) and the second holding block (40) and is supported on the latter and by which the variable length element is held and which permits movements of the variable length element in the longitudinal direction of the variable length element and suppresses movement of the variable length element perpendicular to the longitudinal direction of the variable length element).

Regarding claim 14, Harman discloses the spring element 36 consisting of bent spring sheet, see figure 2, whose spring sections lie in planes which are perpendicular to the longitudinal direction of the variable length element, the bent edges running parallel to the end faces of the optical waveguides.

Regarding claim 18, Harman's holding section 26 has a ferrule 24 in which the optical fiber is fixed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harman (US 5727099).

Regarding claims 2-4, Harman does not disclose the holding element, variable length element and spring sections formed in particular pieces, integral and separate as claimed in these claims. However, it is well known to make elements in a device integral or separable where

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needed, see MPEP 2144.04; In re Larson 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) and In re Dulberg; 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made these three pieces formed from one piece or from separate pieces as claimed in order to achieve greater manufacturing flexibility resulting in reduced costs.

Regarding claims 5-7 and 11-13, Harman discloses the spring element 36 formed by slots (or "holes") in the variable length element, the slots lying in a plane perpendicular to the longitudinal direction of the variable length element, the open edges running parallel to the end faces of the optical waveguides. See figure 2.

Regarding claims 8-10, Harman discloses an even number of slots, see figure 2.

Regarding claim 15, Harman discloses the variable length element under pre-stress in the initial position of the variable length element, by virtue of its being a spring.

Regarding claims 16-17, Harman does not specifically disclose a clip being provided at the top and bottom of each holding block to connect the holding blocks to each other, nor does Harman disclose the clips being produced from one piece with the holding blocks. However, Harman discloses at column 4 lines 30-40 that it is possible to use waveguide support members of other geometries or shapes. It is well known in the art that adding a clip or support member between two holding blocks supports the entire device from oscillations in various directions. It would have been obvious to one of ordinary skill in the art to have modified the invention of Harman to include this clip member because Harman discloses that the support geometry can be varied and this variation would give the device structure greater mechanical support.

Additionally, it is well known to make elements in a device integral where needed, see MPEP

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2144.04; In re Larson 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the clip formed from one piece as claimed in order to achieve greater manufacturing flexibility resulting in reduced costs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumati Krishnan whose telephone number is 571-272-2372. The examiner can normally be reached on 8:00 am - 4:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571-272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SK

  
Stephen Husar  
Primary Examiner